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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,507	10/23/2001	Marlin Stephen Heilman	001086	3933

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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3732

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,507

Applicant(s)

HEILMAN ET AL.

Examiner

Anu Ramana

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 23-36 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-20, 23-36 and 38 is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Amendment***

Applicants' amendment submitted on May 28, 2004 has been entered. Applicants' amendment to claim 16 overcomes the rejections under 35 U.S.C 112, second paragraph with respect to claims 16-20 and 23-24. The finality of the last office action has been withdrawn due to new grounds of rejection in this office action. The indicated allowability of claim 7 in the last office action has been withdrawn in view of the new ground of rejection in this office action.

Applicants are requested to indicate claims 39-42 as being cancelled in the response to this office action to be consistent with the response filed on September 29, 2003.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sherman et al. (US 5,891,159).

Sherman et al. disclose an apparatus for attaching a conduit to a vessel including an enclosure 12 with a port 76 for evacuating air therefrom, a tool 116 with a holding member 117, a conduit 14, a ring or "attachment portion" or "sewing cuff" 26 separable from enclosure 12 (Figures 4, 12, 16A and 16B, col. 1, lines 13-19, col. 8, lines 25-31 and lines 54-66, col. 9, lines 53-67, col. 10, lines 1-18, col. 13, lines 42-67, col. 14, lines 1-2, col. 16, lines 37-48, and col. 17, lines 21-65).

Regarding claims 2, 3, 6 and 7, the method step recitations, "said enclosure being sealed and having air evacuated therefrom prior to attachment to said wall", "said enclosure filled with fluid", "said enclosure having air evacuated therefrom", "said enclosure being filled with fluid" it is noted that the method of using a device is not germane to the issue of patentability of the device itself. Therefore, these limitations have not been given patentable weight.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (US 5,891,159), as applied to claim 1, further in view of Mollenauer et al. (US 6,077,277).

Sherman et al. disclose all elements of the claimed invention except for a tool member with a rotatable barrel member having a cutting blade surrounding a central rod member.

Mollenauer et al. teach a tool member having a rotatable outer tube or barrel member having a cutting blade 46 wherein the central rod can be manipulated to hold material and the outer tube can be rotated to cut material (Fig. 8, col. 1, lines 55-67 and col. 5, lines 5-49).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the tool of Sherman et al. with the tool of Mollenauer et al. for simultaneous grasping and cutting of tissue.

Response to Arguments

Applicants' arguments submitted under "REMARKS," in the response submitted on May 28, 2004 have been considered and are persuasive with respect to claims 16-20, 23-36 and 38 but are not persuasive with respect to claims 1-15.

Regarding Applicants' argument with respect to claim 1, that ring or "attachment portion" 26 is not a separable part of the apparatus, it is the Examiner's position that attachment portion 26 is separable in that it is "capable of being separated" from the Sherman et al. enclosure.

Further, regarding Applicants' arguments on Pages 14 and 15 with respect to the rejection of claims under 35 USC 102(b) as being anticipated by Sherman, it is noted that although claims

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are interpreted in light of the specification, limitations from the specification cannot be read into the claims. *See In re Van Geuns, 988 F.2d 1181, 26USPQ2d 1057 (Fed. Cir. 1993).*

Allowable Subject Matter

Claims 16-20, 23-36 and 38 are allowed.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuradha Ramana*
July 9, 2004


EDUARDO C. ROBERT
PRIME EXAMINER